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1 OF 3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Applicant: Donald Spector

Serial No: 09/384,154

Filed: 08/27/99

For: NETWORK FOR TARGETING INDIVIDUAL OPERATING A MICROCOMPUTER REGARDLESS OF HIS LOCATION

Examiner: Jungwan Chang

Group Art Unit: 2154

Asst. Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of August 13, 2002, by the Primary Examiner of claims 9, 10, 12, and 13, all the claims in the case.

A Notice of Appeal was filed on December 16, 2002, and appropriate extensions of Time obtained through January 13, 2003.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail, in an envelope addressed to : Asst. Commissioner of Patents & Trademarks, Washington, D.C. 20231

Date: February 14, 2003 Reg. No.: 19,555

Signature: Willie Thomas

1. The Real Party In Interest

The real party in interest is Donald Spector

2. Related Applications and Interferences

Appellant has no pending applications related to the instant case, nor has this application been involved in any interference proceedings.

3, Status of Claims

Claims 9, 10, 12, and 13 have been finally rejected under 35 USC 103(a) as being unpatentable over Rosen et al , U.S. patent 6,014,090.

4. Status of Amendments

Appellant's amendment dated October 30, 2002 responding to the Final Office Action of August 13, 2002 was entered.

5. Summary of the Invention

This Invention is directed to a proactive network for targeting an individual operating a microcomputer in order to offer to supply the individual with goods and services at a location to which, or through which, the individual may be traveling without the individual being aware of, or specifically requesting such goods or services.

6. Issues

The issue on appeal is whether the invention as set forth in claims 9, 10, 12 and 13 is obvious under 35 USC 103(a) over the Rosen Reference, U.S. 6, 014,090.

7. **Grouping of Claims**

All of the claims are in a single group.

8. **Argument**

Appellant respectfully submits that his invention as set forth in claims 9, 10, 12 and 13 would not have been obvious at the time his invention was made in light of the Rosen et al reference.

Before discussing the Rosen et al reference, appellant would like to emphasize that his invention as presently claimed is a proactive means for alerting an individual as to the availability of good and/or services at locations to which the individual may travel to or through. The individual traveler does not initially request such goods or services nor is aware that certain goods or services are available, but is made aware of them through a network which offers to supply goods or services on the expectation that the individual might decide to accept such offer.

Hence it is important to note that it is not the individual traveler who is soliciting information regarding the availability of good or services as he or she travels to different locations, but the offer to supply such goods or services is made by a network which knows by a global positioning system where the individual traveler is at a given moment.

The Rosen et al patent provides information to the traveler based on the traveler's geopositioning information. This information is transmitted to resource server that communicates this information with a local establishment. The local establishment

can then post its information and is accessible to the consumer.

Applicant's invention relates to a method whereby hotels, restaurants or other establishments with empty rooms or oversupplies of products or services can make use of a data bank of geopositioning data that shows where possible customers may be. In fact it gives a list of information by accessing the profile of the potential customer. The establishment with an oversupply reduces its price and proactively contacts the user with a special offer which is time related. It is believed that it would be an intrusion on a person's privacy to call them proactively and contact them about a deal, unless the deal was truly discounted.

Unlike the Rosen et al patent, appellant's invention provides a service to the user, For example, it can catch someone on I 95 in Florida with a New York license. It notices that it is 9:00PM . It is responding to a call from a Ramada Inn that has empty rooms in that location and willing to sell them at half price. The geopositioning device is responding to the needs of the establishment, not the customer, but locates a potential customer and makes him or her and offer that is so attractive it can not be refused. The server is asking the goepositioning server for information on people located in its area and then giving that information back to the establishment, which changes its offers by proactively offering the consumer a "special".

Applicant's invention is distinct from the Rosen et al invention in that it is based on the changing inventory needs of the establishments and not simply providing a laundry list of services available to someone in proximity to their place of business. The traveler is not aware of such goods or services until contacted.

It should also be noted that in the Rosen et al method it is the traveler who is seeking information regarding goods or services as opposed to the present invention where the traveler is apprised of available goods and services.

On lines 45 – 55 at column 1 of Rosen et al it is stated under "Summary of the Invention" that a traveler can receive information "upon request". At several other places in the Rosen et al patent it is stated that it is the "user" or traveler who is him or herself the one soliciting the information regarding goods and services. See for example, column 4, lines 64-66 "...a request for a particular facility...", column 6, lines 12-13, " ... the user can select a resource..." and the like.

In appellant's system if, for example, a particular motel on the traveler's route has just inititated a special discounted rate of which the traveler is unaware, this could be offered to the traveler unsolicited whereas in Rosen et al system the user would be unaware of such a discounted rate unless he or she makes a special inquiry.

Appellant respectfully submits that an unsolicited offer made to an individual as to the availability of certain goods or services differs markedly from the same individual who must take the initial step to inquire about the availability of such goods and services. If left to the individual to to inquire, many discounts, promotion schemes, and other time-related benefits might remain unknown if such inquiry is not timely made.

In contrast, under the present invention, the traveler would be made aware of the availability and possibility the cost of goods or services almost instantaneously if she or he happens to be traveling to or through a particular location when changes in the

cost of such goods or services may occur, such as a last minute reduction in hotel rates, cancellation of reservations in an up-scale restaurant, and the like.

Appellant respectfully directs the attention of the members of the Board to his specification wherein at several places it is evident that the availability of goods or services originates not by the individual's inquiry, but by an unsolicited offer or invitation. For example, on pages 6 and 7 of the specification it is stated with respect to the objectives of the invention:

> "Briefly stated, these objects are attained by a network adapted to target an individual operating a microcomputer that is microwave-linked to an Internet highway to offer this individual goods or services appropriate to his needs available at a place within range of the individual's present location. The microcomputer is provided with a GPS receiver that indicates the present location of the individual being transmitted from the microcomputer to a web site on the highway.
>
> At the web site, a computer associated with a data bank storing the profiles of a multitude of consumers is programmed to fine out whether the identified individual is included in the data bank, and to determine from his profile whether there are available at a place reachable from his present location appropriate goods or services, If a match is found, an offer to supply such goods or services is conveyed from the web site to The microcomputer." (underling added)

Also on page 10 of the specification it is stated:

> "For example, if the profile indicates that the individual is a middle aged, well-to-do business man and his present location is in midtown New York City, then programmed computer 16 will transmit from web site 15 to microcomputer 10 an invitation to this individual to have lunch at a nearby restaurant at a substantial discount which will be given by presenting the restaurant with a code number. Or the offer may take the form of an invitation to purchase designer clothing at a discount at a nearby boutique." (underling added)

It is submitted that unsolicited "offers" and "invitations" are not the same as an inquiry by an individual to find the availability of goods and/or services.

What is a unique feature of the present invention is that it uses profile information along with a geopositioning chip to make offers to a person who is traveling, base on the fact that it is known where his or her home base is, what time of day it is where he or she is located. This invention does not send information to John Doe at his home with a special offer. It uses John Doe, who may live in New York, locates him in Florida and makes a local offer to him based on his preferences. The combination of the geopositioning chip, along with preference data, is a unique form of proactive solicitation where somebody is contacted and made an offer specifically in the location when they arrive or pass through.

Appellant therefore respectfully submits that a prima facie case of obviousness has not been made under 35 USC 103(a) in light of the Rosen et al reference. There is nothing in Rosen et al which suggests or would even motivate one of ordinary skill to devise the invention as presently claimed.

Appellant respectfully submits that one must not lose sight of the statutory provisions under which patents are granted to inventors to protect their discoveries. Section 102 if Title 35 indicates that the right of an inventor to a patent is a positive one; that is the inventor shall be entitled to a patent, unless one or more of the subdivisions of the section are applicable. Moreover, Section 103(a), when read in light of the preceding section, must also be considered from the premise that an inventor shall be entitled to a patent, unless the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made.

Hence, the invention in question must be obvious form the reference to that person who has ordinary skill and who is unaware of and has no knowledge of appellcant's discovery. In other words, appellant's invention mush manifest itself, or stand out from the teachings of the reference. In must not be hidden in the teachings of the references only to be uncovered by one who is viewing the art with the knowledge Gleaned from appellant's invention.

While it is often possible to select from the prior art elements which will approximate the invention shown in the application, the fact that such selection can be made does not necessarily preclude the presence of a patentable invention. The test to be given to determine whether an invention is obvious is the "fair suggestion" test. There must be a "fair suggestion" from the prior art as to what appellant has done. It is respectfully submitted therefore, that when the claims under consideration are rejected as being unpatentable over the cited art, that the test to be employed is one of "fair suggestion". It is imperative that the "fair suggestion: test be employed in arriving at a decision. The basic reason for the "fair suggestion" test is based on the fact that the Examiner had had an opportunity to consider and to digest Appellant's disclosure prior to searching the art. As such, it is relatively easy for the Examiner to unintentionally hold that the reference teaches the invention under consideration. It is only when the reference "fairly suggests" the claimed invention that the rejection is proper, and this "fair suggestion" test must be approached without having recourse to the disclosure of appellant's application. (in re Lunsford, 148 U.S.P.R 721).

8. Conclusion

It is respectfully submitted that the Rosen et al reference cited by the Examiner does not suggest the subject matter of appellant's claims. Accordingly, reversal of the decision of the Primary Examiner in the Final Rejection of claims 9, 10, 12 and 13 is respectfully requested.

Appellant's check in the amount of $160 as required by 37 CFR 1.17 (c) is enclosed herewith.

Respectfully submitted,

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February 14, 2003

APPENDIX

The claims on appeal are set forth below:

9. A network for targeting an individual operating a microcomputer in order to offer to supply said individual with appropriate goods or services available at a place within reach of the individual's present location, said network comprising:

means associated with the microcomputer to microwave-link the microcomputer to an Internet highway;

a GPS receiver to indicate the individual's present location;

means to convey over the microwave link from the microcomputer to a web site on the Internet highway, the identification of the individual and the individual's present location, thereby providing his full address;

means at the website storing profiles of a multitude of individuals who are consumers of the goods or services to determine from the profile of individual who's address has been forwarded to the web site, which good or services ae appropriate to said individual and are available at a place reachable form his present address; and

means to convey from the web site to the microcomputer an offer to supply said goods or services.

10. A network as set forth in claim 9, in which said microwave-link is provided by a radio transceiver.

12. A network as set forth in claim 9, in which said microcomputer has an e-mail address that identifies the individual.

13. A network as set forth in claim 9, in which said profiles are stored in a data bank.

LIEBERMAN & NOWAK

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Honorable Commissioner of Patents
Washington, D.C. 20231

U.S. Patent Application Serial No. 09/384,154

Sir:

Enclosed herewith are Appellant's Appeal Brief in triplicate together with check number 2282 in the sum of $160 in accordance with the requirements of 37 CFR 1.17(c).

Respectfully submitted

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